

### **REMARKS**

The Office Action dated August 26, 2004, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 10 has been amended. No new matter has been added. The amendments to the claims do not narrow the scope of the claims. Claims 3-12 are pending and respectfully submitted for consideration.

Claim 10 was objected to for a minor informality. The Applicants have amended claim 10 responsive to the objection and submit that all claims are in compliance with U.S. patent practice.

Claims 3-7, 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Osburn et al. (U.S. Patent No. 3,825,245, "Osburn") in view of Matsumiya (U.S. Patent No. 5,291,662, "Matsumiya"). Osburn was cited for disclosing many of the claimed elements of the invention with the exception of bringing a probe of a coordinate-measuring machine close to the work in the waiting position of the auto-pallet changer and then measuring the forms and dimensions of the work, the coordinate-measuring machine being arranged in the vicinity of the machining tool; and moving a tool of the machining tool and the probe of the coordinate-measuring machine in a horizontal direction of motion and orthogonal to each other. Matsumiya was cited for curing this deficiency. The Applicants traverse the rejection and respectfully submit that claims 3-7, 11 and 12 recite subject matter that is neither disclosed nor suggested by the cited prior art.

With respect to claims 3, 5 and 12, the Applicants submit that Osburn fails to disclose or suggest other claimed features of the invention beyond those acknowledged in the Office Action.

Claim 3 recites placing a work on a waiting position of auto-pallet changer directly after the work has been machined by a tool of the machining tool. Claim 5 recites directly after the work has been machined by a tool of the machining tool and placed on the waiting position. Claim 12 recites a coordinate-measuring machine disposed in the vicinity of a machining tool for getting a probe thereof close to a work in a waiting position of an auto-pallet changer directly after the work has been machined by a tool of the machining tool, and placed on the waiting position, to thereby measure the forms and dimensions of the work. Based solely on the rejection, the cited references do not render claims 3, 5, and 12 obvious. The Office Action took the position that "Osburn discloses a machining tool comprising a tool (40) for machining a workpiece that is placed on a pallet (30) that forms part of an automotive pallet changer that horizontally moves the pallet from a waiting position (47B) to a machining position (32)." See paragraph 3 of the Office Action. Further, Osburn states, "after an interchange has been completed, pallet 50 now on support 47 will have been bodily transferred into the operating position 32 on the machine index table 27." (Emphasis added). See column 3, line 67 to column 4, line 3 of Osburn. There is no disclosure or suggestion, in Osburn, of at least the feature of, placing a work on a waiting position of an auto-pallet changer directly after the work has been machined by a machining tool.

Osburn further fails to disclose or suggest other claimed features of the invention as recited in claims 3, 5, and 12, beyond those acknowledged in the Office Action.

Claims 3, 5 and 12 each recite moving the tool of the machining tool and the probe of the coordinate-measuring machine in a horizontal direction of motion and orthogonal to each other. The Office Action took the position that Figures 2-6 of Osburn disclose a spindle 40 moved in the horizontal direction. However, Figures 2-6 show, and Osburn states "the usual power driven transmissions (not shown) are connected in a well-known manner to effect selective rotation of the tool spindle 40, vertical movement of the spindle head 37 along the Y-axis, and transverse movement of the vertical column 35 along the transverse or Z-axis. The third or X-axis of relative movement is effected by a reversible motor 42 . . . connected to effect relative horizontal movement of the table 24 in either direction along the machine ways 22. (Emphasis added) See column 3 lines 29-39 of Osburn. As such, there is no disclosure or suggestion in Osburn of the spindle 40 moving in a horizontal or x-axis direction as stated by the Office Action.

As acknowledged by the Office Action, Osburn does not disclose a coordinate-measuring machine as recited in claims 3, 5 and 12. As such, Osburn does not disclose or suggest bringing a probe of a coordinate-measuring machine close to the work in the waiting position of the auto pallet changer. Matsumiya was cited for curing this deficiency. However, Matsumiya also fails to disclose or suggest bringing a probe of a coordinate-measuring machine close to the work in the waiting position of the auto-pallet changer, and then measuring the forms and dimension of the work, as recited in claim 3; a coordinate-measuring machine for bringing a probe thereof close to the work in the waiting position of the auto pallet changer, as recited in claim 5; and a coordinate-measuring machine disposed in the vicinity of a machining tool for getting a probe thereof close to a work in a waiting position of an auto-pallet changer directly after the

work has been machined by a tool of the machining tool, and placed on the waiting position, to thereby measure the forms and dimensions of the work, as recited in claim 12.

The 3-D measuring machine of Matsumiya does not disclose or suggest measuring the work at the waiting position of an auto pallet changer. As disclosed in Matsumiya, "the object to be machined (work) can be measured directly at the machining site. The machining condition of the work is measured in real time to prevent the production of inferior goods." See column 14 lines 43-48 of Matsumiya. However, the claims of the present application are directed to the work being moved from the machining tool to the waiting position where the workpiece is measured. Since Matsumiya teaches measuring the work directly at the machining site, the reference does not disclose that the work is measured at waiting position.

Further, there is no motivation or suggestion in either Osburn or Matsumiya for bringing a probe of a coordinate-measuring machine close to the work in the waiting position of the auto-pallet changer after the work has been machined. The Office Action stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the machine tool disclosed by Osburn by adding means for measuring the machined workpiece at a location adjacent to the machining tool to measure the workpiece after it has been machined, as taught by Matsumiya. See page 4 of the Office Action. However, Matsumiya discloses that the object to be machined can be measured directly at the machining site in order to prevent the production of inferior goods. There is no disclosure or suggestion in Matsumiya of moving the work to a location adjacent the machining tool to measure the workpiece. As such, one of

ordinary skill in the art at the time the invention was made, would not have modified Osburn in the manner suggested by the Office Action.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

For at least the combination of foregoing reasons, the Applicants respectfully submit that Osburn and Matsumiya, either singly or in combination, fail to disclose or suggest each and every feature of the claimed invention, and therefore, fail to support a

*prima facie* case of obviousness for purposes of a rejection of claims 3-12 under 35 U.S.C. § 103.

Claim 4 depends from claim 3 and claims 6-11 depend from claim 5. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 3 and 5. Accordingly, the Applicants respectfully request allowance of claims 3-12 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107292-09003.**

Respectfully submitted,



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